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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,335	12/11/2000	Paul C. Ross	1-3	5430
27997	7590	03/21/2006	EXAMINER	
PRIEST & GOLDSTEIN PLLC 5015 SOUTHPARK DRIVE SUITE 230 DURHAM, NC 27713-7736			OUELLETTE, JONATHAN P	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/735,335	<b>Applicant(s)</b> ROSS, PAUL C.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Claim Rejections - 35 USC § 101 and 35 USC § 112

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful

arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. If the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

4. **Claims 1, 6, 11, 14, 17, and 23** are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically:
5. In Claims 1, 6, 11, 14, 17, and 23, the ambiguities cited would make it impossible for the process to be repeatable or “concrete.” In other words, different users would come up with different responses.
6. As per Claims 1, 6, 11, 14, 17, and 23, it appears that the method/system is attempting to sell a broadcasting service, wherein broadcasts are sent to users based on geographic regions and ordered/sorted based on previously established priorities

(specification pg. 9) associated with the broadcasted messages. The independent prioritization criteria could contain a vast amount of different setting combinations; wherein the user established priorities would depend on each user's subjective opinion of the importance of the broadcasted message. Thus, this method/system is not repeatable and would appear to be an attempt to patent an abstract idea not a "concrete" process.

7. Claims 1, 6, 11, 14, 17, and 23 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention lacks a patentable utility, for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 112***

8. The rejection of Claims 1, 6, 11, 14, 17, and 23 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is withdrawn due to Applicant's persuasive arguments.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**10. Claims 1-4, 6-9, 11-12, 14-15, 17-21, and 23-27 are rejected under 35**

**U.S.C. 102(b) as being anticipated by Ernst et al. (US 5,636,245)**

11. As per **independent Claims 1 and 6**, Ernst discloses a method [telecommunications terminal] of operating a telecommunications terminal, said method comprising: receiving a plurality of geographically-sensitive messages (C1 L61-67, C2 L1-24, C2 L59-62) broadcasted to a plurality of telecommunication terminals (C3 L41-45, plurality of remote units), and the plurality of geographically-sensitive messages having associated geographic locations of relevance and priorities (C3 10-30, Incorporation unit; C3 L65-67, C1 L1-4, Pre-designated event specific tags entered at criteria selection unit – priority would be on the list or not on the list); ascertaining a geographic location of said telecommunications terminal (C3 L31-45, remote unit); determining a geographic region of interest of said telecommunications terminal based on said geographic location of said telecommunications terminal; determining whether the geographic location of relevance are within [overlapping] said geographic region of interest of said telecommunications terminal; filtering out the geographically-sensitive messages whose associated geographic locations of relevance are not within said geographic region of interest of said telecommunications terminal; and ordering the unfiltered geographically-sensitive messages according to their associated priorities. (C3 L46-65, Matching Processor, process and disseminate information; C3 L65-67, C1 L1-4, Pre-designated event specific tags entered at criteria selection unit – priority would be on the list or not on the list).

12. As per Claims 2 and 7, Ernst discloses wherein said telecommunication terminal is mobile; and wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a direction of motion of said telecommunications terminal (C3 L31-65, Direction of motion is a product of position, velocity and time).
13. As per Claims 3 and 8, Ernst discloses wherein said telecommunication terminal is mobile; and wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a speed of said telecommunications terminal (Claim 6).
14. As per Claims 4 and 9, Ernst discloses wherein said geographic region of interest is based on the associated priority of said geographically-sensitive message (C3 L37-45, event specific tags – prioritizing events/messages; Claims 17-18, changing region of influence).
15. As per **independent Claims 17, and 23**, Ernst discloses a method [telecommunications terminal] of operating a telecommunications terminal, said method comprising: receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region of relevance (C3 10-30); receiving a plurality of broadcasted geographically-sensitive messages (C1 L61-67, C2 L1-24, C2 L59-62) having associated indicia of geographic regions of relevance (C3 10-30, Incorporation unit, Time information, and Event Specific Tag); ascertaining a geographic location of said telecommunications terminal (C3 L31-45, remote unit); determining geographic regions of relevance from the

associated indicia supplied in the plurality of broadcasted geographically-sensitive messages (C3 10-30); determining a geographic region of interest of said telecommunications terminal based on said geographic location of said telecommunications terminal; determining whether the geographic location of relevance overlap said geographic region of interest of said telecommunications terminal; filtering out the broadcasted geographically-sensitive messages whose associated determined geographic regions of relevance fail to overlap said geographic region of interest of said telecommunications terminal (C3 L46-65, Matching Processor, process and disseminate information).

16. As per Claims 18 and 24, Ernst discloses wherein said telecommunication terminal is mobile; and wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a direction of motion of said telecommunications terminal (C3 L31-65, Direction of motion is a product of position, velocity and time).
17. As per Claims 19 and 25, Ernst discloses wherein said receiver is also for receiving a definition of said geographic region of relevance, and further comprising a memory for storing said definition of said geographic region of relevance and an indicium of said geographic region of relevance as an index into said memory (C3 L46-65, Matching Processor; Claim 1 and Claim 17, Regions of interest/region of influence).
18. As per Claims 20 and 26, Ernst discloses wherein said telecommunication terminal is mobile; and wherein said geographic region of interest is based on said geographic



location of said telecommunications terminal and on a speed of said telecommunications terminal (See Claim 6).

19. As per Claims 21 and 27, Ernst discloses wherein said geographic region of interest is based on the associated priority of said geographically-sensitive message (C3 L37-45, event specific tags – prioritizing events/messages; Claims 17-18, changing region of influence).
20. As per **independent Claims 11 and 14**, Ernst discloses a method [telecommunications terminal] of operating a telecommunications terminal to filter geographically-sensitive messages which are broadcasted to a plurality of telecommunication terminals (Abstract; C3 L41-45, plurality of remote units), said method comprising: receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region (C3 10-30); receiving a plurality of broadcasted geographically-sensitive messages having associated indicia of a geographic region of relevance (C3 10-30, Incorporation unit, Time information, and Event Specific Tag); ascertaining a geographic location of said telecommunications terminal; determining a geographic region of relevance from the associated indicium supplied in a broadcasted geographically-sensitive message (C3 10-30); and determining whether said geographic location of said telecommunications terminal is within the determined geographic region of relevance; and disregarding the broadcasted geographically-sensitive messages when said geographic location of said telecommunications terminal is not within the determined geographic region of

relevance (Claim 1; C3 L46-65, Matching Processor, process and disseminate information).

21. As per Claims 12 and 15, Ernst discloses receiving a definition of each geographic region of relevance and an indicium of said geographic region of relevance before receiving said geographically-sensitive message; and storing said definition of said geographic region of relevance into memory with said indicium of said geographic region of relevance as an index into said memory (C3 L46-65, Matching Processor; Claim 1 and Claim 17, Regions of interest/region of influence).

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 23. Claims 5, 10, 13, 16, 22 and 28 are rejected under 35 U.S.C. 103 as being unpatentable over Ernst.**

24. As per Claims 5, 10, 13, 16, 22 and 28, Ernst does not expressly show wherein said geographic region of interest comprises at least one of a polygon and a conic section.
25. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The telecommunications terminal operating system would be performed regardless of the shape of geographic region of interest used. Thus, this descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a geographic region of interest in a shape comprising at least one of a polygon and a conic section, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

#### ***Response to Arguments***

27. Applicant's arguments filed 9/14/2005, regarding Claims 1-28, have been fully considered but are moot in view of the new ground(s) of rejection.
28. The Applicant has made the argument that the cited prior art fails to disclose a broadcasted message having a priority and ordering the unfiltered messages according to that priority as claimed.
29. However, as explained by the 101 and 112 rejections above, the prioritization element of the broadcasted message is neither repeatable nor concrete, due to the subjective nature of establishing the priority of the broadcasted message; and thus, the priority feature has no patentable utility. Therefore, the argument is moot.
30. The Applicant has also made the argument that the cited prior art fails to disclose the particular selection criteria for determining whether a broadcast message should be filtered out.

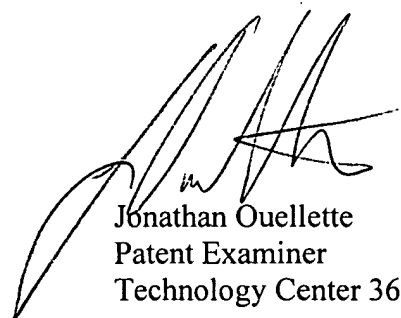
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31. However, Ernst discloses filtering-out messages to users based on a criteria selection input of remote unit positions (geographic regions), velocities, and times (C3 10-45), as disclosed by the independent claims.

*Conclusion*

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
34. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

March 3, 2006



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600